

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____

)
)
) Decision on
) Petition for Review
) Under 37 CFR Section 10.2(c)
)

MEMORANDUM AND ORDER

_____, petitioner, seeks review and reversal of the decision of the Director of the Office of Enrollment and Discipline (OED) denying petitioner's request for higher scores on the afternoon section of the Patent Practitioner's Examination held on May 3, 1995. The petitioner's request for reversal of the decision of the Director of OED is denied.

Background

Petitioner originally scored 60 out of a possible 100 for the afternoon section of the Patent Practitioner's Examination held on May 3, 1995 ("Exam"). To the original score of 60, 4 points were restored on regrade (decision dated Nov. 16, 1995); no points were added in the Decision on Request for Reconsideration of Decision on Regrade (decision dated June 3, 1996). Petitioner timely requested review of the Decision on Request for Reconsideration of Decision on Regrade of the Examination held On May 3, 1996, of the Director of OED, under 37 CFR Section 10.2(c). No petition for review of the morning section was made.

The portion of the afternoon section of the Exam selected by the petitioner required that she draft four claims directed to an improved nozzle assembly. Specific instructions were provided to the test taker regarding the aspects of the nozzle assembly that were to be claimed. The grading of claims 1 and 2 are in dispute. Even though petitioner requests the Commissioner to review the grading of Claim 2, the grading of Claim 2 was not raised in her previous request for regrade or her request for reconsideration of the decision on regrade. The request for regrading claim 2 was raised

for the first time on July 2, 1996. Petitioner had until the November 8, 1995, deadline to make this regrade request. See 37 C.F.R. § 10.7(c). Consequently, the request for review of claim 2 is denied as untimely. See also 37 C.F.R. § 10.2(c) (petition to Commissioner will be decided on the basis of the record made before the Director).

The following table provides the language from petitioner's claim 1 in dispute, including a brief explanation of why the grader entered point deductions for various aspects of petitioner's claim 1. Each disputed item is discussed separately below.

SUMMARY OF DISPUTE

Item No.	Claim	Petitioner's Examination Answer	
1	Claim 1	An improved nozzle assembly for a high volume low pressure paint spray gun comprising:	
2		a fluid tip having a rear externally threaded end and a front right circular conic end, said conic end having a vertex axially adjacent orifice [sic] ,	No antecedent basis for bolded language, -2 points
3		said orifice [sic] being axially aligned with said fluid tip,	
4		and said fluid tip defining an internal axial bore extending from said thread end to said orifice [sic];	unnecessary limitation, -2 points
5		a radial flange on said fluid tip comprising a plurality of orifices [sic] uniformly spaced around said flange circumference and communicating with an atomization air chamber;	
6		said air chamber being separated into a rear chamber and a forward chamber of said flange;	unnecessary limitation, -2 points
7		an air distribution baffle radially mounted between said flange and external threaded end of said fluid tip,	

SUMMARY OF DISPUTE

Item No.	Claim Limitation	Petitioner's Examination Answer	Point Deduction In Dispute
8	Claim 1 (con't)	said baffle having a calibrated oriface [sic] and an annular groove which extends around a threaded perimeter of said baffle;	three unnecessary limitations, -6 points
9		an air cap having an axial passage,	
10		a rear cylindrical portion ,	unnecessary limitation, - 2 points
11		a first conic surface	unnecessary limitation, - 2 points
12		a second conic surface and	unnecessary limitation, - 2 points
13		a front axial opening that extends flush with a front face and said opening in conjunction with said fluid tip oriface [sic] define an annular atomization air discharge oriface [sic];	Omitted necessary limitation, -3 points (an air cap having a front face and an axial front opening flush with said front face)
14		a threaded retainer ring radially mounted about said air cap,	unnecessary limitation, - 2 points
15		said ring being threaded onto said baffle perimeteter [sic] hereby securing air cap to fluid tip and forming nozzle assembly.	

Points were deducted from petitioner's claim for Item Nos. 2, 4, 6, 8, 10, 11, 12, 13 and 14 as provided above. Each Item disputed is discussed below.

DISPUTED LANGUAGE IN CLAIM 1

Item No. 2

The grader deducted two points for failing to provide an antecedent basis for the element “having a vertex axially adjacent orifice [sic].”

Petitioner argued in her request for regrade and in this petition, that the Exam materials recite “having a vertex 29 axially adjacent orifice 22” and that punctuation should be present to indicate that these are two separate elements. Petitioner further reasoned that because punctuation is not present, she should have been given credit for the phrase used in her claim 1.

Petitioner’s argument is considered, but not deemed persuasive for two reasons. First, the inference of an antecedent basis does not logically follow from her premise of missing punctuation. Second, the examination materials are clear and unambiguous in describing the invention to be claimed. In particular, the paragraph of the examination materials where the phrase “having a vertex 29 axially adjacent orifice 22” appears is preceded by the following description of the fluid tip.

Details of fluid tip 12 are shown in FIG. 3 of the drawings and include an axial bore comprising a long cylindrical section 21 extending from externally threaded end 17, followed by a tapered conic section 24, and terminating in a short cylindrical section 23 leading to a paint discharge orifice 22.

Examination Materials, p. 18, lines 10-13.

Accordingly, no points are restored.

Item Nos. 4, 6, 8, 10-12 and 14.

The highlighted structures in Items Nos. 4, 6, 8, 10-12 and 14 were deemed to be unnecessary structures for drafting an answer claim 1 consistent with the Exam’s instructions. These instructions specifically state: “Claim 1 must be the broadest claim for a nozzle assembly which defines the invention as set forth in the OBJECTS OF THE INVENTION. . . .” Exam Materials, page 20, lines 2-4.

Two points were deducted for each unnecessary limitation. The instructions of the examination state that points will be deducted for claiming unnecessary claim limitations in independent claim 1. Furthermore, the structures in Petitioner's claim for which points were deducted were not set forth in the OBJECTS OF THE INVENTION and thus are not properly part of claim 1.

In particular, the axial bore is described in the disclosure in the "details of the fluid tip." See Exam, p. 18. Therefore, the broadest claim need not include an express limitation to the axial bore, especially in light of the further instructions that dependent claim 3 should "cover those features of the fluid tip not otherwise required in claim 1." See Exam, p. 20. Similarly, the rear chamber is described in the "details of the fluid tip," and therefore is an unnecessary limitation for purposes of claim 1. Accordingly, since these limitations are not described as objects of the invention, the deduction of two points for each unnecessary limitation is proper.

In Item No. 8, the three unnecessary limitations are described in the detailed description of the baffle on page 19 of the Exam materials and are not set forth in the objects of the invention. Item Nos. 10, 11 and 12 are limitations to the air cap that are not described in the materials as objects of the invention. Each limitation of Item Nos. 10, 11, and 12 appear in the detailed description of the air cap in the exam materials page 19, second paragraph. Accordingly, the deduction of two points for each unnecessary limitation is proper.

Similarly, the threaded retainer ring of Item No. 14 is another unnecessary limitation for claim 1. Accordingly, the deduction of two points for an unnecessary limitation is proper.

Item No. 13

Petitioner's request for review of the claim language of Item 13 is denied as untimely under 37 C.F.R. § 10.7(c). This issue was raised for the first time on July 2, 1996, therefore OED has not addressed it. See 37 C.F.R. § 10.2(c) (petition to Commissioner will be made on the basis of the record made before the Director). Accordingly, no points are restored.

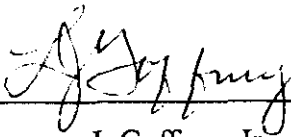
ORDER

Upon consideration of the petition to the Commissioner, the conclusion of the Director of the Office of Enrollment and Discipline is affirmed.

ORDERED that the petition is denied.

8/30/96

Date

A handwritten signature in cursive script, appearing to read "L. J. Goffney, Jr.", written over a horizontal line.

Lawrence J. Goffney, Jr.

Acting Deputy Assistant Secretary of Commerce
and Deputy Commissioner of Patents
and Trademarks

cc: